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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,356	12/03/2003	Ronald Perrella	030533	9002

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EXAMINER
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ESTRADA, ANGEL R

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/726,356

Applicant(s)

PERRELLA ET AL.

Examiner

Angel R. Estrada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11, 2, 3 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Kabenjian et al (US 2004/0076048, hereinafter Kabenjian).

Regarding claim 11, Kabenjian discloses a wall plate (102), comprising: a first surface; a second surface opposite the first surface; four side edges connected to the first and second surfaces (see figure 1); and a printed circuit board (122) having a USB hub circuit (see figure 1 or paragraph [0018] or [0022]) connected thereto wherein the printed circuit board is connected to the second surface (see figure 1)

Regarding claim 2, Kabenjian discloses the wall plate (102), wherein the wall plate (102) is fabricated from an insulating material (paragraph [0029]).

Regarding claim 3, Kabenjian discloses the wall plate (10), wherein the first surface includes a planar portion (see figure 1).

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Regarding claim 5, Kabenjian discloses the wall plate (102), wherein the wall plate defines a rectangular-shaped opening (see figure 1) extending from the first surface to the second surface.

Regarding claim 6, Kabenjian discloses the wall plate (102), wherein the wall plate (102) defines a plurality of rectangular-shaped openings (see figure 1 or 104, 106, 108, 110) extending from the first surface to the second surface (see figure 1).

Regarding claim 7, Kabenjian discloses the wall plate (102), wherein the wall plate (102) defines four rectangular-shaped openings (see figure 1 or 104, 106, 108, 110) extending from the first surface to the second surface (see figure 1).

2. Claims 11, 3, 4, 12, 18 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsai (US 6,466,434).

Regarding claim 11, Tsai discloses a wall plate (see figure 2a), comprising: a first surface; a second surface opposite the first surface; four side edges connected to the first and second surfaces (see figure 2a); and a printed circuit board (see figure 2a) having a USB hub circuit (see figure 2a) connected thereto wherein the printed circuit board is connected to the second surface (see figure 2a).

Regarding claim 3, Tsai discloses the wall plate (see figure 2a), wherein the first surface includes a planar portion (see figure 2a).

Regarding claim 4, Tsai discloses the wall plate (see figure 2a), wherein the first surface including a tapered portion (see figure 2a).

Regarding claim 12, Tsai discloses the wall plate (see figure 2), wherein the USB hub circuit (see figure 2a) includes a plurality of USB connectors (21).

Regarding claim 18, Tsai discloses a wall plate (480 or see figure 4), wherein the USB hub circuit includes: a downstream USB connector (column 4 lines 5-13) that extends through a first opening defined by the wall plate (see figure 4); and an indicating light (42) associated with the downstream USB connector, wherein the indicating light extends through a second opening defined by the wall plate (see figure 4).

Regarding claim 20, Tsai discloses the wall plate (480 or see figure 4), wherein the USB hub circuit (see figure 3) includes a power supply (36).

Regarding claim 21, Tsai discloses the wall plate (480 or see figure 4), wherein the power supply (36) includes a transformer (column 3 line 65-column 4 line 4).

Regarding claim 22, Tsai discloses the wall plate (480 or see figure 4), comprising: a first surface; a second surface opposite the first surface; four side edges connected to the first and second surface (see figure 4); and means for transmitting and receiving a USB signal (see figure 3), wherein the means for transmitting and receiving the USB signal is connected to the second surface (see figures 3 and 4).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable Kabenjian et al (US 2004/0076048, hereinafter Kabenjian).

Regarding claim 8, Kabenjian discloses the wall plate (102) having a rectangular opening (see figure 1) extending from the first surface to a second surface (see figure 1); but Kabenjian lacks said opening being a circular shaped opening. It would have been an obvious matter of design choice to change the shape of any opening on the wall plate from rectangular to circular, since such a modification would have involved a mere change in the shape of a component.

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Where the instant specification and evidence of record fail to attribute any significance (novel or unexpected results) to a particular shape, a change of shape is generally recognized as being within the level of ordinary skill in the art. *Span-Deck Inc. V. FabCon, Inc.*, 215 USPQ 835.

Regarding claim 9, Kabenjian discloses the wall plate (102) having a plurality of rectangular openings (see figure 1) extending from the first surface to a second surface (see figure 1); but Kabenjian lacks said openings being circular shaped openings. It would have been an obvious matter of design choice to change the shape of the plurality of openings on the wall plate from rectangular to circular, since such a modification would have involved a mere change in the shape of a component. Where the instant specification and evidence of record fail to attribute any significance (novel or unexpected results) to a particular shape, a change of shape is generally recognized as being within the level of ordinary skill in the art. *Span-Deck Inc. V. FabCon, Inc.*, 215 USPQ 835.

Regarding claim 10, the modified Kabenjian discloses the wall plate (102) defines four circular-shaped openings (see figure 1) extending from the first surface to a second surface (see figure 1).

4. Claims 13-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (US 6,466,434).

Regarding claim 13, Tsai disclose the wall plate (see figure 2a), wherein the USB hub circuit includes an upstream and a downstream USB connector (column 1 lines 29-39); but lacks having four downstream connectors. It would

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have been obvious to one having ordinary skill in the art at the time the invention was made to make the wall plate with four downstream connectors instead of two, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.

Regarding claim 14, the modified Tsai discloses the wall plate (see figure 2a), wherein each of the four downstream USB connectors extend through openings defined by the wall plate (see figure 2a).

Regarding claim 15, Tsai discloses the wall plate (480 or see figure 4), wherein the USB hub circuit includes an indicating light (42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the wall plate with a plurality of indicating lights, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.

Regarding claim 16, the modified Tsai discloses the wall plate (480 or see figure 4), wherein the USB hub circuit includes four indicating lights (see figure 4).

Regarding claim 17, the modified Tsai discloses the wall plate (480 or see figure 4), wherein each of the four indicating lights (see figure 4) extend through openings defined by the wall plate (see figure 4).

Regarding claim 19, Tsai discloses the claimed invention except for the USB hub circuit including a plurality of downstream USB connectors and a plurality of associated indicating lights. It would have been obvious to one having



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ordinary skill in the art at the time the invention was made to make the wall plate with a plurality of downstream USB connectors and a plurality of indicating lights, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.

### ***Response to Arguments***

5. Applicant's arguments filed on October 31, 2004 have been fully considered but they are not persuasive.

In response to the applicants arguments that the preamble of claims 11 and 22 breath life and meaning into the claims and constitutes a limitation thereto, the Examiner states that it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Furthermore, the Examiner definition of a wall plate is any plate capable of being mounted to a wall. Tsai (US 6,466,434) and newly cited reference, Kabenjian et al (2004/0076048) disclose a wall plate because the plate can be mounted on a wall.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection, for claims 2-10, presented in this Office action. Accordingly, **THIS ACTION IS**

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**MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (571) 272-1973. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 Ext: 31. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Angel R. Estrada

November 19, 2004

 1/10/05  
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